

REMARKS

In response to the Office Action dated January 17, 2006, Applicant presents the following remarks traversing the rejections made. In light of these remarks, favorable reconsideration of all non-allowed claims is respectfully requested.

On a preliminary note, Applicant observes that claim 24 is neither rejected on any statutory ground nor indicated as allowable. If this claim is allowable, then Applicant would appreciate receiving an indication to this effect. If this claim is not allowable, Applicant would appreciate receiving an indication as to why such is the case so that an appropriate response can be made.

Turning to claim 1, it requires a wall covering including a non-woven fiber tissue or mat and a thermoplastic polymer coating covering the outer side of the non-woven fiber tissue or mat in a continuous fashion to reduce significantly the porosity of the wall covering. The thermoplastic polymer coating further provides a roller paintable, visible outer surface on the non-woven fiber tissue or mat. This continuous coating covering the outer surface of the tissue or mat is also free of random discontinuities. These discontinuities not only increase porosity, but also are susceptible to creating visible irregularities when roller painted.

The Action first contends that the language of claim 1 requiring that the "porosity of the wall covering is reduced significantly" by the polymer coating is indefinite "because the claim is comparing to what is the porosity is reduced . . . is Applicant trying to refer to a reduction of the porosity of the non-woven fiber tissue or mat instead?" Aside from being difficult to decipher, this statement apparently disregards the fact that claim 1 expressly requires that the porosity of the overall wall covering is reduced by the polymer coating covering the non-woven fiber tissue or mat. No reasonable interpretation of the claim or reading of the language would cause a skilled artisan to query whether it is the wall covering or the fiber tissue or mat that has reduced porosity. Indeed, the Examiner's interpretation is strained, since the porosity of the fiber tissue or mat itself remains unchanged as a result of the polymer covering, even though the porosity of the overall wall

covering is reduced. Since the language used is perfectly clear and would be easily understood by a skilled artisan, it is believed that the claim is definite and the rejection unfounded.

For reasons that are not well understood, the Examiner also points to paragraph [006] of the specification, contending that it "discloses that the polymeric coating covers the surface of the mat, thereby reducing *the porosity of the mat* significantly[,] [n]ot the porosity of the wall covering as claimed." Although the importance of this passage from the specification in terms of the patentability of any claim is unclear, the statement made in the Action is completely false. Paragraph [006] in Applicant's published specification explains as follows:

In one preferred embodiment of the present invention, a polymeric coating is introduced to the outer surface of the glass fiber tissue material. The polymeric coating is a thermoplastic material that covers the surface of the glass fiber tissue, **thereby reducing porosity significantly**. This allows less paint to be applied to the surface to create an aesthetically pleasing outer surface. The polymeric material used in the polymeric coating is a thermoplastic polymer composition that exhibits good adhesion to both the glass fiber tissue and to the paint. The polymeric material also preferably has a degree of gas permeability to allow moisture to escape from underneath, thereby preventing mold growth in the wall covering material.

(emphasis added). Contrary to the Examiner's statement, this passage does not state that "the porosity of the mat" is reduced. Rather, it suggests that the polymeric coating, when applied to the mat, reduces the porosity of the combined structure, which of course is the wall covering of the present invention.

Next, the Examiner continues to posit that claim 1 recites new matter and allegedly violates the strictures of Section 112, first paragraph, because there is "no expressed support for the limitation that the coating is free of random discontinuities." First of all, as Applicant has pointed out several times, U.S. Patent law does not in any way mandate "expressed support" for a limitation in the specification. Rather, it is sufficient if the originally filed disclosure would have conveyed to one having ordinary skill in the art that

the inventor had possession of the concept of what is claimed.¹ Despite citing no authority to the contrary, the rejection of claim 1 on this basis still stands. Accordingly, Applicant respectfully requests that the Examiner either provide legal support for the position that "expressed support" is required or withdraw the rejection as unfounded.

Secondly, even if the Examiner's position were legally correct, the factual predicate for a written description rejection is lacking. As Applicant previously pointed out, full support for the "negative" limitations in claim 1 may be found in paragraph 6 of the published application, as well as in the drawing figures (see, e.g., Figure 2 illustrating the continuous, uninterrupted coating 54 free from random discontinuities covering the non-woven fiber tissue or mat 52 to thereby significantly reduce the porosity of the wall covering). Since the drawings form part of the written description, "expressed support" for the limitation at issue is provided. Indeed, the Examiner does not in any way contend that the drawings do not illustrate the claimed feature, so the rejection should be withdrawn as lacking factual support. Otherwise, the substantial evidence required to reject the claim would be lacking.

Moving on to the rejection of amended claim 1 based on Jackson, the Examiner curiously now takes the position that "the claimed 'random discontinuities' are macroscopic discontinuities that would be visible to the unaided eye which are different from the microscopic discontinuities of the Jackson reference." Based on the Examiner's own admission, the Jackson reference discloses something that is structurally different from what is being claimed. Applicant has thus carried its "burden" to show that the structure of Jackson is different. Accordingly, withdrawal of the rejection based on anticipation grounds is respectfully requested.

Further, as shown in Applicant's Figure 2, the claimed coating (not just the surface) is free of random discontinuities that, if otherwise present, would substantially increase porosity of the wall covering. As also discussed in more detail in Applicant's specification, the significant reduction in porosity provided by covering the substrate with such a

¹ In re Anderson, 471 F.2d 1237, 176 USPQ 331(CCPA1973).

continuous, uninterrupted layer, as opposed to simply forming an interrupted layer with holes through it, substantially reduces the amount of paint required to form an aesthetically pleasing surface. This is because the paint will not simply leak through the holes in the layer and wastefully become absorbed by the underlying substrate. The practical result is an estimated 50-66% reduction in the amount of paint required (see ¶ 32 of Applicant's published application), which may advantageously allow for the application of only a single coat of paint to the polymeric coating.

In stark and total contrast, Jackson discloses a wall covering having a "porous polymeric ply . . . fused to and supported by a nonwoven substrate ply" (emphasis added). At column 3, lines 51-55, Jackson expressly defines "porous" and "continuous" synonymously as referring to "the existence of a multitude of small holes, openings or gaps in the polymeric ply of the wallcovering," not just its surface. Noteworthy is the fact that Jackson, choosing to be his own lexicographer, selected a definition of the word "continuous" that does not comport with the ordinary meaning of "uninterrupted."²

Jackson thus does not disclose, teach or otherwise suggest a coating that covers the non-woven mat in a continuous fashion (giving "continuous" its ordinary meaning) and free of random discontinuities, as shown in Applicant's Figure 2. In fact, this reference actually teaches away from such an arrangement by virtue of the critical need for holes in the outer ply of the wall covering (see, e.g., col. 5, lines 45-51, "The key feature of the coating or plastisol application process is that the plastisol is applied very thinly to the nonwoven substrate ply . . . [which] results in small discontinuities, holes, or gaps, which upon fusion form miniature holes or pores in the fused polymeric ply" (emphasis added)). Jackson is also completely silent as to whether the polymeric ply covers the nonwoven substrate in a manner that would in any way facilitate painting (not printing),

² Intellicall, Inc., v. Phonometrics, Inc., 952 F.2d 1384, 1388, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992) ("An inventor may 'be his own lexicographer and . . . give terms uncommon meanings.'"), but cf. Jonsson v. Stanley Works, 903 F.2d 812, 820, 14 USPQ2d 1863, 1871 (Fed. Cir. 1990) ("[w]ords in a claim . . . [are] given their ordinary and accustomed meaning.")

including by way of a roller. Accordingly, claim 1 as amended is believed to distinguish over Jackson.

The Action also maintains the rejection of claims 23-35 based primarily on Jackson "as further evidenced by" the Abstract of WO 95/07946. However, neither reference discloses, teaches, or suggests the invention of claim 23 as a whole, including a layer of paint roller-applied to a thermoplastic polymer coating applied to a non-woven fiber tissue or mat. Since this express element of claim 23 is completely disregarded in the formulation of the anticipation rejection, favorable reconsideration is requested.

Despite including all limitations of an allowable base claim, the independent patentability of several of the claims depending from claim 23 over Jackson and the other cited references is also emphasized. For example, claims 28 and 29 require a mineral filler to form a non-smooth outer surface. These claims stand rejected based on the combination of Jackson in view of Ishii et al. (which is never discussed in the rejection) and Penz et al. Again, Penz et al. is cited as disclosing a glass mat reinforced thermoplastic suitable for the production of paintable parts comprising a thermoplastic matrix polymer, one or more glass mats, and a fine-particle mineral fiber. The primary contention made in support of the rejection is that "[s]ince both Jackson et al and Penz et al. are from the same field of endeavor, the purpose disclosed by Penz et al. would have been recognized in the pertinent art of Jackson et al."

The difficulty is that a skilled artisan would not combine Jackson and Penz et al. to arrive at the present invention. Specifically, one of ordinary skill in the art would not use the teaching of Penz et al. to include a mineral filler in the chemical composition of the polymeric coating to create a non-smooth surface in combination with Jackson, when in fact Jackson expressly teaches that such a feature is not a desirable attribute of a wall covering (see, e.g., col. 2, lines 5-12). Accordingly, Jackson and Penz et al. are simply not properly combinable, and even if combined do not lead to the inventions of claims 28 and 29.

The Examiner further attempts to justify the combination by taking the position that both Jackson and Penz et al. "avoid having 'smooth' surfaces." This is completely false. Jackson extols the desirability of providing a wall covering with a smooth outer surface (see Abstract, line 1), and simply does not contemplate imparting a mineral filler to create a non-smooth outer surface to facilitate roller painting. Thus, Jackson actually teaches away from the claimed invention, and otherwise fails to motivate a skilled artisan to combine the teachings of Penz et al. to provide a wall covering with a non-smooth outer surface formed using a mineral filler.

As for reliance of Ishii et al. in the rejection of claims 10, 13, 32, 35, and 38-39, absolutely no reason is provided to explain why a skilled artisan would combine the teachings of this reference with those of Jackson to arrive at the claimed invention. Rather, the Examiner simply selects bits and pieces of the prior art teachings as necessary to meet the terms of Applicant's claimed invention. Such a hindsight approach using Applicant's specification and claims as a blueprint has long been rejected as improper.³ Absent such a motivation or suggestion in the prior art, the rejections relying on Ishii et al. cannot stand and should be withdrawn.

Regardless of the lack of any motivation for making the combination, dependent claim 35 also requires that the polymeric material comprises approximately a 45/5/50 by weight mixture of high-density polyethylene, titanium dioxide, and a dispersion, said dispersion comprising ground calcium carbonate and ground titanium dioxide in high density polyethylene. The primary reference to Jackson specifically requires a plastisol as a component of the polymer coating, which by definition includes a plasticizer. Such is clearly excluded by the plain terms of claim 35, which does not recite a plasticizer as a part of the 100 weight percent of the polymeric material.

In attempting to sidestep this very clear point of fact, the Examiner asserts that the open ended claim language "comprising" does not limit the claim to the addition of other structures. While no doubt correct from a legal standpoint, this assertion completely

³ In re Ochiai, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), citing In re Fine, 837 F.2d 1071, 1075, 5

overlooks the fact that the claimed structure cannot total more than 100% by weight! Nothing in the secondary reference to Ishii et al. alters this basic tenet of matter so dependent claim 35 should be allowed.

With specific regard to claim 39, the Examiner contends that Jackson "discloses the claimed invention except that it teaches the use of titanium oxide instead of titanium dioxide." This statement is not true, since Jackson fails to disclose, teach, or suggest in any way a mixture of high-density polyethylene or a dispersion comprising ground calcium carbonate and ground titanium dioxide in high density polyethylene. Even if Ishii et al. discloses titanium dioxide, and assuming for the sake of argument that the references are properly combinable, it does not otherwise supply the teaching missing from Jackson necessary to render the invention of claim 39 obvious. Accordingly, since the cited combination of references fail to teach every limitation of the claim at issue, a *prima facie* case of obviousness is lacking.

The Action also includes a rejection of claim 36 as anticipated by Jackson "as further evidenced by" the Abstract of WO 95/07946. Claim 36 expressly requires a "rigid" fiber tissue or mat. In stark contrast, Jackson teaches that the structure allegedly corresponding to the claimed tissue or mat is "soft." Nevertheless, the Examiner asserts that "the term soft means smooth or delicate in texture, grain or fiber" (but without supplying any copy of the definition used). On the basis of this random definition, it is concluded that the fact that Jackson "refers to a soft fabric does not preclude that it forms a rigid structure."

First of all, it is again emphasized that precedential decisions make clear that "[i]ndiscriminate reliance should not be placed on layman's definitions found in dictionaries."⁴ Rather, the reference itself must always be consulted to determine the meaning of the term. Jackson at several locations uses the word "smooth" to describe the substrate ply, including in the same sentence with the word "soft" (see, e.g., col. 2, lines 40-

U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

⁴ *Ex parte Kumagai*, 9 USPQ2d 1642 (BPAI1988) (citing *In re Salem*, 533 F.2d 676, 193 USPQ 513, 518 (CCPA 1977) with approval and noting that "the lay definition of 'discrete' relied upon by the examiner does not even suggest its applicability to [this] technical area.")

44). Accordingly, it would appear that the layman's meaning of "soft" ascribed by the Examiner cannot be the correct one, or else Jackson would not have used it consistently throughout instead of also using the word "smooth."

Regardless, an important point is overlooked: The fact that Jackson "does not preclude" a rigid structure does not mean that it "discloses" a rigid structure for purposes of an anticipation rejection. Indeed, the Office Action points to nothing in Jackson that in any way discloses, teaches, or suggests the claimed rigid fiber tissue or mat. Using the Examiner's same logic, the mere fact that Jackson mentions a soft structure does not mean it is necessarily rigid (and the "mere possibility" that such is the case cannot support an anticipation rejection). Since the rejection is thus based on a *non-sequitur* and the Examiner otherwise carries no part of her burden of showing that Jackson within its four corners discloses the non-woven rigid fiber tissue or mat of claim 36, or that such would be inherent, a *prima facie* case of anticipation is lacking.

Although believed to be allowable as dependent on an allowable base claim, the independent patentability of several of the claims depending from claim 36 is also emphasized. For instance, dependent claim 2 requires that the outer surface of the polymer coating has a surface tension of at least approximately 30 dynes/cm. In the Office Action, it is acknowledged that Jackson is completely silent as to the claimed surface tension, and no other reference is cited as allegedly supplying this missing teaching. However, the Examiner somehow concludes that Applicant is claiming a "process step" and that it would be "inherent to the product of the prior art as it meets all the structural limitations of the present invention."

First of all, the product of the prior art does not meet "all the structural limitations of the present invention." For one, the prior art product does not include the claimed surface tension. Contrary to the Examiner's position, this is indeed a structural limitation of the claim, not a "process step."⁵

⁵ With regard to the assertion that the claimed surface tension constitutes a functional limitation or process step, the Examiner's attention is directed to Hazani v. U.S. International Trade Commission, 44 USPQ2d 1358 (Fed. Cir. 1997), in which it was held that the limitation "chemically engraved" in a claim describes the

Secondly, the basis for the rejection is contrary not only to the Manual of Patent Examining Procedure, but also precedential decisions holding that "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."⁶ Not only do the steps described for forming the Applicant's claimed wall covering differ completely from those outlined in Jackson, but Applicant's processing involves a treatment designed to impart a particular surface tension in order to facilitate roller painting. As acknowledged in the record, Jackson fails to mention the surface tension of the substrate or any steps taken to alter it, so it cannot possibly anticipate the claimed invention. Rather than reciting a "process step," Applicant is reciting a structural quality of the claimed element, which is no different than claiming it has a particular size or shape. Although a claim element requiring a particular size or shape may require processing to achieve the claimed result, this does not somehow make the limitation a "process" step. Therefore, reconsideration of the rejection of dependent claim 2 is respectfully requested.

In the alternative, the Examiner asserts that the "presently claimed function of surface tension . . . would have obviously been provided as a result of the product of" Jackson, apparently relying on a theory of "obviousness by inherency." However, "[t]hat which may be inherent is not necessarily known" and "[o]bviousness cannot be predicated on what is unknown."⁷ Moreover, "a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection."⁸ Since Jackson nowhere contemplates, teaches, suggests, or even discusses surface tension to improve the

product more by its structure than by the process used to obtain it. See also *In re Garner*, 412 F.2d 276, 278-79, 162 USPQ 221, 223 (CCPA 1969) ("it seems to us that the recitation of the particles as 'interbonded one to another by interfusion between the surfaces of the perlite particles' is as capable of being construed as a structural limitation as 'intermixed,' 'ground in place,' 'press fitted,' 'etched,' and 'welded,' all of which at one time or another have been separately held capable of construction as structural, rather than process, limitations").

⁶ See *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) and Section 2112, MPEP generally.

⁷ *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966).

⁸ *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

roller paintability of a wall covering, it standing alone cannot possibly make it known to provide a surface tension within the claimed range.

Despite being rejected based on the combination of Jackson and Ishii et al. alone, claim 13 is also rejected based on this combination in further view of Melber et al. Again, the primary reference to Jackson specifically requires a plastisol as a component of the polymer coating. By definition, a plastisol includes a plasticizer. Such an added component is clearly excluded by the plain terms of claim 35, which does not recite a plasticizer as a part of the 100 weight percent of the polymeric material. Nothing in Melber et al. supplies the teaching missing from Jackson that would render the claimed composition unpatentable; namely, elimination of the plasticizer. Thus, the combination of references simply cannot teach the invention of claim 13.

Claim 40 requires a thermoplastic polymer with a mineral filler forming a visible outer, non-smooth roller paintable surface of a wall covering with a non-woven tissue or mat having a visible inside surface as well. As noted above, Jackson specifically extols a smooth outer surface, and concomitantly disparages a non-smooth outer surface. The Examiner fails to in any way explain how Jackson meets the claimed non-smooth limitation, and in fact, even asserts to the contrary in the Office Action (see page 3, para. c.). Despite this admission, the Examiner still rejects as anticipated a claim requiring the exact opposite structure as that taught in the prior art. Since this administrative government action deprives Applicant's due process rights in fairly having its claimed inventions adjudged for patentability, Applicant respectfully requests that the Examiner either supply the requisite substantial evidence for rejecting the claim or else withdraw the rejection as unfounded.

In view of the foregoing remarks, Applicant submits that claims 1-13 and 22-40 are allowable over the cited prior art and respectfully requests favorable treatment. In the event the Examiner agrees, Applicant will also submit the information necessary to address the Section 112 rejection made with respect to dependent claims 8 and 30. In the meantime, the Examiner is invited to telephone the Applicant's undersigned attorney at (740) 321-7167

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if any unresolved matters remain, and may debit any fees due from Deposit Account 50-0568.

Respectfully submitted,

By: 
Margaret S. Millikin
Reg. No. 38,969

Owens Corning
Patent Dept. Bldg. 11
2790 Columbus Road
Granville, Ohio 43023
(740) 321-5359